

### REMARKS

Applicants have amended the preamble of claims 12 and 13 to be consistent with that of claim 6, from which they depend. Applicants have also added new claims 14, 15, and 16 to more particularly point out and distinctly claim subject matter which they regard as their invention.<sup>1</sup> Applicants submit that the new claims do not necessitate further consideration and search. Indeed, they all depend from claim 6, which is patentable for reasons discussed below.

Claims 6-16 are currently pending. Consideration of this application, as amended, is requested in view of the following remarks.

Claims 6-13 are rejected under 35 U.S.C. § 103(a) as being obvious on two grounds. Each ground is respectfully traversed below.

#### I

The Examiner rejects claims 6, 7, and 9-13 for obviousness, relying on Chang et al., U.S. Patent 4,138,381 (Chang). Independent claim 6 will be discussed first.

Claim 6 covers a composition useful for vibration damper. The composition, having a solid content of 60-85%, contains a thickener, a water-based copolymer latex, and an inorganic filler.

Chang discloses a polymeric thickener that can improve properties of paints, e.g., good flow and good sag resistance. See the abstract. It describes paint compositions containing a polymeric thickener, a water-based latex, and a filler. See column 2, lines 38-41. Nowhere in this reference is taught or suggested a paint composition that has a solid content of 60-85%, as required by claim 6. Indeed, it teaches a solid content lower than that range. More specifically, the composition of example 1 contained a solid content of 56% and the compositions of examples 8-15 and 19-20 contained solid contents of 45%.

Referring to Chang's exemplary compositions, the Examiner asserts that "it would have been obvious to one skilled in the art at the time the invention was made to appropriately alter the solid[] range in [the] prior art to accommodate more filler or binder content and thereby obtain the instant invention." See the Office Action, page 3, lines 12-15.

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<sup>1</sup> Support for new claims 14-16 can be found in the specification, page 22, line 7 through page 23, line 6.

Applicants disagree and would like to bring to the Examiner's attention that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Chang teaches paint compositions with desirable properties, i.e., good flow and good sag resistance. It does not suggest increasing the solid contents of the paint compositions from 56%, the highest described in Chang. Indeed, one skilled in the art, in view of this reference, would not have been motivated to prepare a composition having a solid content higher than 56%. Clearly, Chang does not suggest the desirability of modifying the compositions described therein by increasing their solid contents from 56% to 60-85% to arrive at the composition of claim 6 (which is a vibration-damping composition, not a paint composition). Without such a suggestion, "the mere fact that [Chang's compositions] could be so modified would have not have made the modification obvious." See the *Gordon* holding quoted above. In other words, claim 6 is not rendered obvious by Chang.

For the reasons set forth above, claims 7 and 9-13, all dependent from claim 6, are also not rendered obvious by Chang.

## II

The Examiner rejects claims 6-13 for obviousness, relying on Nonweiler et al., U.S. Patent 5,610,215 (Nonweiler) in view of Shay et al., U.S. Patent 5,478,602 (Shay). Again, independent claim 6 will be discussed first.

As mentioned above, claim 6 covers a composition containing a thickener, a water-based copolymer latex, and an inorganic filler. For 100 parts of the solid portion in the composition, the thickener makes up 0.01-2 parts, the copolymer latex makes up 10-60 parts, and the inorganic filler makes up 40-90 parts.

Nonweiler describes an aqueous emulsion-based coating composition containing a thickener, a latex, and a filler. This reference is silent on the ratio of each of the three components to the solid portion in the composition. In the other words, it does not teach or suggest the specific amounts of the thickener, the latex, and the filler relative to the solid portion in the composition recited in claim 6.

Shay does not cure this deficiency. It discloses an associative polymeric thickener prepared from unsaturated carboxylic acid, unsaturated monomer, and hydrophobe-containing macromonomer. It further describes a composition containing a thickener, a latex, and a filler. However, like Nonweiler, it is also silent on the specific amounts of the thickener, the latex, and the filler relative to the solid portion in the composition recited in claim 6.

In sum, Nonweiler and Shay, alone or in combination, do not teach or suggest the composition of claim 6. Thus, contrary to the Examiner's belief, claim 6 is not rendered obvious by Nonweiler in view of Shay.

For the reasons set forth above, claims 7-13, dependent from claim 6, are also not rendered obvious by Nonweiler in view of Shay.

#### CONCLUSION

Applicants submit that the rejections asserted by the Examiner have been overcome and claims 6-13 are therefore patentable over the cited prior art. New claims 14-16, all dependent from claim 6, should also be in condition for allowance. Applicants therefore request that the Examiner allow all pending claims.

Enclosed is a \$120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 6-5-06

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